

## IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Intre application of: Barnes, Thomas M., et al. (as amended)  
Application No.: 10/042,431 Group No.: 1652  
Filed: October 25, 2001 Examiner: Nashed, Nashaat T.  
For: NOVEL GENES ENCODING PROTEINS HAVING DIAGNOSTIC,  
PREVENTIVE, THERAPEUTIC AND OTHER USES

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

RESPONSE TO RESTRICTION REQUIREMENT

Dear Sir:

Responsive to the Restriction Requirement dated December 24, 2003, the claims of Group 25 (claims 19, 20, 22 and 28-30), drawn to a method of identifying a compound that binds to the polypeptide of SEQ ID NO's:47-52, respectively, are elected for prosecution with traverse. In order to be fully responsive, Applicants hereby elect to prosecute the claims drawn to a method of identifying a compound that binds to the polypeptide of SEQ ID NO:47, without prejudice to Applicants' right to pursue the non-elected subject matter in other applications in the event a generic claim is not found allowable

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GROUPS FOR TRAVERSAL

The Examiner states that the application contains multiple independent and patentably distinct inventions (inventions of Group 1-37) and has required restriction under 35 U.S.C. § 121. According to the Examiner, the application contains claims directed to the following inventions:

Groups 1-6 (Claims 1-7 and 12), drawn to nucleic acids, vectors, host cells and a recombinant method to make the polypeptide of SEQ ID NO's:47-52, respectively;

Group 7-12 (Claims 8-10), drawn to polypeptides of SEQ ID NO's:47-52, respectively;

Group 13-18 (Claims 11, 13-15 and 23), drawn to antibodies raised against the polypeptide of SEQ ID NO's:47-52, respectively, and method of use;

Group 19-24 (Claims 16-18 and 37-42), drawn to a hybridization probe and method of detecting nucleic acid encoding the polypeptide of SEQ ID NO's:47-52, respectively;

Group 25-30 (Claims 19, 20 and 22 (claims 28-30 are also included in Group 25 only)), drawn to methods for identifying a compound that binds to the polypeptide of SEQ ID NO's:47-52, respectively;

Group 31-36 (Claim 21(claims 31, 32, 34-45, 47, 48, 50 and 51 are included in group 31)), drawn to methods of modulating the activity of the polypeptide of SEQ ID NO's:47-52, respectively; and

Group 37 (Claims 33, 46 and 49), drawn to a method of making a pharmaceutical composition for TANGO 294-like lipase.

The Examiner has required election of a single invention on the basis that the above listed groups encompass independent chemical entities or are different methods. Applicants respectfully request modification of the Restriction Requirement, and propose that Groups 25 and 27 be combined.

It is the Examiner's opinion that "[T]he polypeptides of Groups 7-12 are independent chemical entities and require different searches in the patent and non-patent literature." As such, the Examiner has restricted the claims of Groups 25-30 under the presumption that SEQ ID NOs:47-52 are independent chemical entities and require different searches. Applicants note,

however, that the method claims of Groups 25-30 are all directed to methods for identifying a compound that binds to TANGO 294 polypeptides of the present invention (see details below).

Group 25 – drawn to a method for identifying a compound that binds to the polypeptide of SEQ ID NO:47 (corresponds to the full length version of TANGO294).

Group 26 – drawn to a method for identifying a compound that binds to the polypeptide of SEQ ID NO:48 (corresponds to the TANGO294 signal sequence).

Group 27 – drawn to a method for identifying a compound that binds to the polypeptide of SEQ ID NO:49 (corresponds to the mature form of TANGO294).

Group 28 – drawn to a method for identifying a compound that binds to the polypeptide of SEQ ID NO:50 (corresponds to the extracellular domain of TANGO294).

Group 29 – drawn to a method for identifying a compound that binds to the polypeptide of SEQ ID NO:51 (corresponds to the transmembrane domain of TANGO294).

Group 30 – drawn to a method for identifying a compound that binds to the polypeptide of SEQ ID NO:52 (corresponds to the cytoplasmic domain of TANGO294).

Therefore, by performing searches on the elected method for identifying a compound that binds to the polypeptide of SEQ ID NO:47 of Group 25, the searches would necessarily also encompass the subject matter of Group 27, as the entire sequence of the mature form of the TANGO294 polypeptide (SEQ ID NO:49) is included within the sequence of the full length version of TANGO294 (SEQ ID NO:47).

Furthermore, the proposed regrouping comports with the United States Patent Office Procedure as stated in the Manual of Patent Examination Procedure:

If the search and examination of an entire application can be made without serious burden, the Examiner must examine it on the merits, even though it includes claims to independent or distinct inventions (M.P.E.P § 803 at 800-3 (8<sup>th</sup> ed., Aug 2001)).

Therefore, Groups 25 and 27 should be combined into one distinct group, since no additional burden would be placed on the Examiner by the concurrent search and examination of the new combined group. Applicants' suggestion to modify the Restriction Requirement by combining the claims of Groups 25 and 27, should not be construed as an indication that

Applicants believe that the patentably distinct claims within the joined groups stand or fall together.

If the Examiner agrees to the proposed modification, Applicants elect the combined Groups 25 and 27. Claims readable thereon are claims 19, 20, 22 and 28-30 (now new claims 52-75), drawn to a method for identifying a compound that binds to or modulates the activity of the polypeptide of SEQ ID NOs:47 and 49.

This paper is being filed timely as no extensions of time are required. In the event any extensions of time are necessary, the undersigned hereby authorizes the requisite fees to be charged to Deposit Account No. 501668.

Entry of the remarks made herein is respectfully requested.

January 26, 2004

Respectfully submitted,

MILLENNIUM PHARMACEUTICALS, INC.

By



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Limited Recognition Under 37 C.F.R. §10.9(b)

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